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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,126	06/27/2001	Jan Juriga	AT000036	4889

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EXAMINER
SORKIN, DAVID L

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/893,126	Applicant(s) JURIGA ET AL.
	Examiner David L. Sorkin	Art Unit 1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *19-21*.

   Claim(s) rejected: *13-18 and 22-27*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DETAILED ACTION

1. Applicant states "applicants' attorney believes that the admitted prior art, found on pages 1 and 2 of the applicant, is more material than the Gerson patent". If applicant or applicant's attorney or agent is aware of information material to patentability, it must be disclosed in accordance with 37 CFR §§1.56, 1.97 and 1.98. As stated in 37 CFR § 1.56, "The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98." An IDS filed 09 January 2002 lists two references, US 5,310,259 and DE 3447741. No other disclosure of information material to patentability has been received. See MPEP chapter 2000 regarding the duty to disclose information material to patentability and MPEP 609 (III) concerning the requirements of an Information Disclosure Statement. See especially MPEP 609 (III)(A)(1) which states that a list of information must be supplied on a separate sheet of paper, not incorporated into the specification. Furthermore, nowhere on pages 1 or 2 of the specification is the term "prior art" used. While it is stated in lines 25-27 of page 1, "a hand-held mixer of the type defined in the first paragraph ... has been put on the market in different versions by the applicant and is therefore known", if applicant causes applicant's own invention to "known or used" publicly, such being known or used is necessarily after applicant invented the invention and is not prior art under 102(a). Also, being "known or used" only constitutes 102(a) prior art if it occurred in the United States. The specification does not state what, if any, of the "versions" was sold more

than one year before filing of the instant application for the purposes of section 102(b). Finally, applicant provides very little structural detail concerning the "known" mixers.

2. The proposed amendments would not alleviate the rejection of claims 22-27 under section 112, first paragraph. Applicant's remarks do not directly address this issue. Applicant appears to touch upon the issue under the heading "Claim indefiniteness", however, a rejection under section 112, first paragraph is unrelated to indefiniteness. The instant specification states on page 5, lines 11-12, "To actuate the speed switching means, first movable actuating means 19 have been provided". It is entirely unreasonable for applicant to now argue that the "actuating means 19" is not the "means for actuating the speed switching means" of claim 22, but instead elements not associated with the word "actuating" in the specification are the "means for actuating". While the specification associates the function "actuating" with other structural elements, (see for example page 5, lines 27-28, "second movable actuating means 21 having been provided" and page 8, lines 30-31, "can be actuated by means of an actuating pin 101") these are not the structures that applicant now argues are the "actuating means" and these other structural elements associated with "actuating" are not for actuating the speed switch means, but instead are for actuating the start means. In summary, in view of the clear statement on page 5, lines 11-12 of the specification, "To actuate the speed switching means, first movable actuating means 19 have been provided" one skilled in the art would consider "actuating means 19" to be corresponding structure for the "means for actuating the speed switching means" of claim 22 and that because "actuating means 19" is not disclosed to be part of a

"module" which includes the other elements of claim 22, applicant did not have possession of the claimed invention at the time of filing.

3. Applicant argues that rejections of claims as anticipated by Gerson (US 3,533,600) are improper. Applicant states regarding the instant invention "It is inherent that this mechanical connection is made before the module is installed in the apparatus". However, "The patentability of a product does not depend on its method of production" *In re Thorpe,* 227 USPQ 964, 966 (Fed. Cir. 1985). Applicant discusses the word "module" and "Webster's New World Dictionary"; however, applicant does not quote a definition from the dictionary nor does applicant supply a copy of the appropriate page of the dictionary. Applicant asserts that the word "module" requires a detachable unit; however, even if such were the case, applicant does not explain how this distinguishes the claims from Gerson ('600). Firstly, claim 22 is only to a "module", so even assuming the "detachable" requirement, it is not required to be detachable from any claimed element and the module may "comprise" any number of additional structural elements. Secondly, regarding claim 13, the module may "include" elements not explicitly claimed as part of the module. For example "two mains terminals" are part of the module according the specification, but not claim 13. All the listed elements of the claim could be part of a "module" and still be within the scope of the claim. The module of Gerson ('600) is at least detachable from the "mixing, beating, or blending elements".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David Sorkin

July 21, 2003

TONY G. SOOHOO
PRIMARY EXAMINER